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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,889	03/15/2005	Karl J. Wood	GB 020151	5830
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EXAMINER				
SAGER, MARK ALAN				
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3714				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,889

Applicant(s)

WOOD, KARL J.

Examiner

M. Sager

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3 and 6-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-3, 6-7 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A program (clm 13) per se does not define patentable subject matter and presently the program is not encoded on computer readable medium so as to realize its functionality when executed by a computer. Per decision of *Bilski*, an invention having a claimed method that is neither tied to another statutory category nor transforms underlying subject matter to another state or thing is non-statutory. The facts of this application coincide with the facts of *In re Bilski*, thus, this invention claims non-statutory subject matter. *Diamond v Diehr*, 450 USPQ2d 175, 184 (1981). *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed Cir 2008). See MPEP 2106. See

<http://ptoweb/patents/3700/documents/101.memo.01.07.09.pdf>,

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_101_05_15_2008.pdf and

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf.

Claim Interpretation

3. Per MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are (A) "adapted to" or "adapted for" clauses, (B) "wherein" clauses, and (C) "whereby" clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case.

In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.* In this case, the 'wherein' clauses state an environment of use, intended result or the clause fails to state a condition material to its patentability as provided in further evidence below.

4. Per MPEP 2114, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the manner of use fails to critically distinguish over structure performing process as shown by references in evidence below.

Claim Rejections - 35 USC § 102

5. Claims 1 and 6-13 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Final Fantasy XI. This holding is maintained

from prior action as incorporated herein. Response to Applicant/Counsel remarks is provided below and incorporated herein. Cumulative information regarding Final Fantasy XI (FF XI hereafter) as shown by evidence from Wikipedia and Final Fantasy Official website, FF XI is a massively multiplayer online role-playing game (see as evidence under MPEP 2131.01 of MMORPG definition as per description of massively multiplayer online role-playing game by Wikipedia) that has a game program to permit a game system such as PlayStation 2, Xbox 360 or Microsoft Windows PC to play the game when connected to the Square Enix Final Fantasy XI Official website that hosts the game where the particular game system connects to the FF XI server website that includes a processor that reads the computer readable storage means (see description of FF XI as reported by Wikipedia) to carryout the steps of loading the computer program, executing the computer program, receiving instructions from a user interface to start playing the game free of charge such as during a free trial period from the Square Enix website (see Monthly service fees @ Final Fantasy XI Official Website that permits thirty day free trial period with subsequent subscription period(s)), changing the game status according to instructions and charging a user to store game status such as charging one dollar for each additional character created/stored (see Monthly service fees @ Final Fantasy XI Official Website and see Comparison of MMORPGs regarding Final Fantasy XI as reported by Wikipedia), wherein charging a user a first amount to store game status for a predetermined time period and charging a user a second amount to store game status for an unlimited time period where 'unlimited' is interpreted to be a longer duration/period than the predetermined time period wherein first amount increases over predetermined time period (free first thirty days, \$12.95 monthly subscription fee thereafter and \$1 fee each month for each added Content ID, see

Monthly service fees @ Final Fantasy XI Official Website and see Comparison of MMORPGs regarding Final Fantasy XI as reported by Wikipedia), wherein charging is debiting a user's account (see Monthly service fees @ Final Fantasy XI Official web site and see Comparison of MMORPGs as reported by Wikipedia and see Final Fantasy XI Credit Cards as reported by Wikipedia), wherein user's account is credited following specific changes in the game status such as charging one dollar for each added character that Square Enix calls Content ID (see Monthly service fees @ Final Fantasy XI Official web site and Comparison of MMORPGs regarding Final Fantasy XI as reported by Wikipedia), wherein said system is integrated and has a distributed architecture communicating via the internet (see description of Final Fantasy XI as reported by Wikipedia), wherein charging means comprises a cash receiver (such as debiting account to receive funds/payment, supra).

Regarding first amount increases over predetermined time period and a number of storages is limited to a predetermined number during a specified time period, FF XI includes increasing the amount by either of two situations 1) free play + a paid subscription and/or 2) a paid subscription of one duration (i.e. 1 month) transition to a paid subscription of a longer duration (i.e. 2 months or longer) thereby increasing over the predetermined period where the period of use is as per each particular subscription period that a particular user subscribes and the user is limited to a predetermined number of storages due to having a fixed number of character slots (i.e. 1) thereby number of storages is limited to a predetermined number during a specified period since player may only store a predefined number of characters. Also, when a player pays an added fee for each additional character (i.e. \$1), then that user is limited to adjusted number of storages for a period based on adjusted price for that subscription period.

Claim Rejections - 35 USC § 103

6. Claims 2-3 are rejected under 35 U.S.C. 102 (a) as anticipated by Final Fantasy XI or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Final Fantasy XI in view of Diablo. This holding is maintained from prior action as incorporated herein. Response to Applicant/Counsel remarks is provided below and incorporated herein. Cumulative references that describe FF XI show FF XI game includes claimed steps/features (supra), and further includes pausing the game status in response to specific instruction from user interface and changing the game status according to instructions when a player logs out from game play (see description of Final Fantasy XI as reported by Wikipedia and description of MMORPG game by Wikipedia and description of Role-playing game for Real time with pause by Wikipedia). The Office asserts that pausing play due to player logging out their character or logging off from the server is performing same function for same purpose. Alternatively, Final Fantasy XI discloses claimed method (supra) but lacks pausing the game status for a predetermined period of time in response to a specific instruction from user interface and further changing the game status according to instructions after step (f). Entering a pause or continue [un-pausing] game status by user input in a real-time game is old and well known as shown by Diablo (pg 17) for allowing user to pause play of a game at their leisure; while, description of Role playing video games by Wikipedia shows real time with pause game play. Thus, it would have been obvious to an artisan at a time prior to the invention to apply the process of pausing the game status according to a specific instruction from user interface and further changing the game status according to instructions after step (f) as taught by Diablo to improve the method of FF XI game for the predictable result of allowing user to pause and continue [un-pause] play of a game. The

combination of FF XI in view of Diablo and real-time with pause discussed by Wikipedia provides same structure performing same function.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over FF XI in view of Sato (4858930) and/or Lennon (5078399). This holding is maintained from prior action as incorporated herein. Response to Applicant/Counsel remarks is provided below and incorporated herein. Alternatively, where cash receiver requires currency acceptor (bill, coin or token), the cumulative references that describe FF XI show FF XI game includes claimed steps/features, but lacks a cash receiver as a currency acceptor for accepting bill or coin or token. Pay to play game machine that accepts currency are old and conventional such as taught by Sato and Lennon. Thus, it would have been obvious for an artisan at a time prior to the invention to apply the process of a cash receiver as taught by Sato or Lennon to improve the method of FF XI for the predictable result of paying to play via bill/coin/token input such as an arcade machine.

Response to Arguments

8. Applicant's arguments with respect to claims 1-3, 6-7 and 13 have been considered but are moot in view of the new ground(s) of rejection. The cited claims are non-stat for same reasons as present in decision in In re Bilski cited above.

9. Applicant's arguments filed 4/9/09 have been fully considered but they are not persuasive. In reply to Applicant remark on page 6-7 that FF XI fails to increase fee charged during the predetermined period, the Office disagrees as maintained from prior action in that FF XI increases fee in at least two different situations as stated above incorporated herein as from free play increasing to paid subscription or a paid subscription from one duration increasing to a paid subscription of longer duration where cost of subscription includes expense to store

character(s) based on fee(s) paid and the number of storages is limited in FF XI to a predefined number of characters for basic subscription. Applicant's failure to consider scope of claims and the process of use of subscription + fee for each additional character as taught by FF XI is not persuasive. In essence, the manner of use is not differentiated from FF XI where number of storages is number of storage slots available to create a character and where subscription fee of an online game (i.e. MMORPG) includes use of memory to store game state. Contrary to Applicants opine on page 7, the increase in fee from free play to paid subscription over the predetermined period and a predefined number of slots to create character limits the number of storages in FF XI is same process using same structure for same purpose.

The scope of 'predetermined period' is a variable period based on particular period of use as disclosed by specification paragraphs 16, 39 of PG PUB 2005/0277476 that similarly within FF XI the fee increases over predetermined period as by happenstance of use where transitions either from free play to paid subscription or from a paid subscription of one duration to a paid subscription of longer duration and the number of storages is limited as per FF XI due to a predefined number of slots being available with basic account whether that is during free play or during paid subscription. The fact that FF XI permits a fee for added storage does not alter its anticipation for breadth of function claimed in that the claimed process does not exclude process of subscription payment + fee for each added character performing steps by same structure for same purpose (charging players use of system to include storage for storing state of game characters).

The Applicant argues patentability of claims 2-3 and 12 solely upon dependence to claim 1 and 8 respectively for above cited function of first amount increases over said predetermined

period and a number of storages is limited to a predetermined number during a specified time period, thus, the Office response above is incorporated herein.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/
Primary Examiner, Art Unit 3714